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10/674,054

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Jeffrey Taylor

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HAYNES AND BOONE, LLP

IP Section

2323 Victory Avenue

Suite 700

Dallas, TX 75219

EXAMINER

THOMPSON, MICHAEL M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/674,054	Applicant(s) TAYLOR ET AL.	
	Examiner Michael M. Thompson	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-6, 9-10, 17-21, 25, and 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Goeller et al. (US 7,200,658).**

3. **With respect to claims 1, 17 and 25,** Goeller et al. teaches a computer implemented method of predicting the geographic location of a user of a communication network based on the user's network address, the method performed by a computer system having an operatively interconnected processor, memory and communications interface (i.e. at least via the server systems); the method comprising: obtaining via a communications network and the communications interface, user-reported data purportedly disclosing respective geographic locations of a plurality of users of the communications network (i.e. via the users data when the device generates request data packets thereby purportedly disclosing respective geographic locations received at each internet hop as shown in the Abstract, col. 2, line 21 to col. 3, line 20, col. 4, lines 47-67, col. 5, lines 32-58, and Figs. 1-5); storing the geographic location data in the memory of the computer system (i.e. obtaining

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and storing the user internet hop data at least via a database for the proposition that the ICANN database is a part of the network and holds additional geographic location data in the memory such as that shown in Figure 5 and description thereof, where the information may potentially include such information as addresses (postal) are taught at col. 2, line 53- col. 3, line 5 and can be combined with the user data purportedly disclosing the internet hop geographic locations to determine a persons likely location as described in later steps); obtaining a respective network addresses for each of the plurality of users (i.e. via IP addresses); storing each of the network addresses in the memory of the computer system (i.e. at least via the Geo filtering Server where the addresses are stored for comparison); operating the processor of the computer system to correlate the stored geographic location data with the stored network address data and to generate predictive data identifying a predicted geographic location for a network address based on the stored geographic location data for multiple users (i.e. at least via Figure 3 wherein the Geo-filtering server looks up each IP address against the databases such as ICANN); storing the predictive data in the memory; and operating the processor to reference the predictive data stored in the memory and to identify a predicted geographic location of a particular user of the communications network as a function of a network address through which the particular user accesses the communications network (i.e. at least via col. 2, line 53- col. 3, line 16, the prior art teaches that the correlating of information or “predictive data” in the memory of the geo-filtering system server is then identifies a predicted

geographic location of the users in the network by way of the network addresses as described above).

With respect to claim 17, the Goeller et al. process is stored on computer medium as shown in the figures and is similarly rejected under the method of claim 1.

With respect to claim 25 and those claims that depend from it, Goeller et al. also teaches (4) when a user of the network visits the website, predicting the user's geographic location based on the predictive geographic location data and the users IP address as described above. (i.e. In particular, this is the main purpose and role of the Goeller et al. patent as described in conjunction with AOL, Yahoo, etc. further in conjunction with and cooperation of the system).

4. **With respect to claims 2 and 18**, Goeller et al. teaches the method of claim 1 further comprising determining, for each network address, a rating of the likelihood that the predicted geographic location accurately reflects the geographic location of users who access the network through that network address (i.e. at least shown in the Abstract; Col. 2, lines 36-42; Col. 3, lines 17-31; Col. 6, lines 16-32; Col. 6 line 58 through Col. 9, line 39, for the proposition that 4 of 5 similar hops is explicitly if not inherently rating the accuracy of the location). Given the language set forth in claim 1, these limitations are considered a further recitation of the intended use, in connection with the step of correlating geographic location data. In a claim drawn to a process of predicting, the intended use must result in a manipulative difference as compared to prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Therefore, the

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instant claim has not been given patentable weight. Furthermore, the specific composition of the predicative data is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The obtaining, storing and correlating steps would be performed the same regardless of what type of predicative data it is. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01.

5. **With respect to claim 3 and 19**, Goeller et al. teaches the method of claim 2 further comprising determining, for each network address, a plurality of overlapping predicted geographic areas of increasing size, and, for each such geographic area, a rating of the likelihood that the predicted geographic area accurately reflects the geographic location of users who access the network through that network address. (i.e. As per claim 3, this claim similarly rejected over that of claim 2 under a similar rational. The claim furthers the intended use and would similarly be considered a nonfunctional recitation).

6. **With respect to claim 4**, Goeller et al. teaches the method of claim 3 further comprising determining at least a city and a state in the geographic areas of increasing size (i.e. Col. 3, lines 7-16). As per claim 4, this claim similarly rejected over that of claim 3 under a similar rational. The claim furthers the intended use and would similarly be considered a nonfunctional recitation.

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7. **With respect to claim 5**, Goeller et al. teaches the method of claim 1 further comprising determining one or more of a home or business address and a telephone number in the geographic location data. (i.e. In the least addresses (postal) are taught at col. 2, line 53- col. 3, line 5). Regardless, the specific composition of the geographic location data is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The obtaining, storing and correlating steps would be performed the same regardless of what type of geographic location data it is. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01.

8. **With respect to claims 6 and 29**, Goeller et al. teaches the method of claim 1 and 25 wherein step (1) comprises obtaining said geographic location data voluntarily from said users. (i.e. this is inherent in the data collection of Goeller et al. since users who use the internet and fail to block, hide, or secure their identifiable information such as through their user reported data, IP address or browser, and are voluntarily offering the data.)

9. **With respect to claims 9, 21 and 30-31**, Goeller et al. teaches the method of claim 1 and 25 wherein said geographic location data comprises the users' self reported addresses. As per claims 9, 21 and 30 these claims are similarly rejected over that of claims 1 and 6.

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10. **With respect to claims 10 and 32**, Goeller et al. teaches the method of claim 1 wherein step (2) comprises reading and storing at a node of the network the network address of users who access data at that node through the network. (i.e. node address storage is taught on Figure 5, col. 2, lines 53- col. 3 line 5 and col. 5)

11. **With respect to claim 20**, Goeller et al. teaches the product of claim 19 wherein said plurality of geographic areas of increasing size comprise at least a city, a state, and a country. Goeller et al. explicitly teaches a plurality of geographic areas of increasing size of a city, state and country. In addressing the geographic area of the country, Goeller et al. teaches the United States as a geographic region (As previously show in claim 4).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 2-3, 11-13, 18-19, 22-23, 27-28 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goeller et al. in view of Hampton (US 7,062,572).**

14. **With respect to claims 11, 22 and 33** Goeller et al. teaches all of the limitations of the method in claims 1 and 17 respectively, except for explicitly reciting

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further comprising the steps of: (4) obtaining data indicative of the integrity of the geographic location data; and wherein step (3) further comprises further correlating the geographic location data and network address data with the integrity data to generate a rating of the likely accuracy of the predictive geographic location data.

Hampton teaches mapping the geographic location of an internet user by an IP address based on data of stored IP addresses and corresponding mapping requests that are accompanied by an accuracy rating or confidence factor. It would have been obvious to one of ordinary skill in the art to have modified the Goeller et al. process for determining location and mapping of internet users with the ability to determine the accuracy or confidence of the results with data that is indicative of the integrity of the geographic location as taught by Hampton merely for providing greater accuracy and assurance in determining the geographic location as taught by the reference. It should be noted that despite the Examiner's rejection, the language directed to generating a rating and claim 12 are considered intended use of the data correlation.

15. **With respect to claims 2-3, 12, 18-19, 23, 27-28 and 34,** Goeller et al. teaches the method of claims 1, 11; 17, 22; and 25 respectively, except for explicitly reciting that the predictive data comprises, for each network address, a plurality of overlapping predicted geographic areas of increasing size, and, for each such geographic area, a rating of the likelihood that the predicted geographic area accurately reflects the geographic location of users who access the network through that network address. In the least, Goeller et al. explicitly teaches a plurality of geographic areas of increasing size of a city, state and country, while Hampton

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teaches the rating as in claim 11 above. These claims may be similarly rejected under the combination of claim 11 as well.

16. **With respect to claim 13**, Goeller et al. teaches the method of claim 11 wherein step (1) comprises obtaining said geographic location data voluntarily from said users. As per claim 13, this claim similarly rejected over that of claim 6 and 9 under a similar rational.

17. **With respect to claim 26**, Goeller et al. teaches the method of claim 25, except for explicitly reciting the method further comprising the step of: (5) providing geographically targeted advertising to users who visit a website on the internet based on the predictive geographic location data. Hampton teaches providing geographically targeted advertising. It would have been obvious to one of ordinary skill in the art, at the time of invention, to have modified the Goeller et al. reference to include geographically targeted advertising as taught by Hampton for the well known purpose of marketing products in different geographic regions, for example, specific to the regional sales and or stores to provide an enhanced shopping experience and to provide regional advertising similar to well known mail circulars to increase sales and patronage. Regardless, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to combine geo-location technology with geo-location targeted advertising. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable. (See KSR [127 S Ct.

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at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”)

18. Claims 7-8, 14, 16, 27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goeller et al. in view of Hampton and further in view of Black et al. (US 2003/0023541).

19. With respect to claim 7-8, 14, and 27, Goeller et al. and Hampton teach the method of claims 7 and 13, except for explicitly reciting the steps of operating a website on the Internet and asking users of the website to self report information indicative of their geographic locations. Black et al. teaches the self reporting of information such as your shipping or billing address in order to make a purchase over the website. It would have been obvious to one of ordinary skill in the art, at the time of invention, to have modified the combination of Goeller et al. and Hampton to further comprise the ability to provide the user the ability to self report their shipping or billing address that is indicative of their geographic location for the well known purpose of confirming the billing information and/or shipping information and/or security in logging IP addresses for a purchaser to obtain geographic location of a purchaser to mediate fraud. Specifically with respect to claims 7 and 8, the reporting of the geographic location is inherent in providing the billing/shipping address. Regardless, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to combine geographic location technology with a retail website or sales website or otherwise in order to confirm and/or provide internet security through logging of IP addresses. The claimed invention is merely a combination of

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old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”)

20. **With respect to claims 16 and 36**, Goeller et al., Hampton teach all the limitations of claims 1, 12-14 and 25-27 respectively, except for explicitly reciting that an entity sells goods via the website and requires a user, when purchasing goods, to self report an address to which the user wishes the goods to be shipped and a payment vehicle to which the cost of the goods is to be charged and wherein the integrity data comprises a rating based on a correlation of the self reported ship to address and a billing address for the payment vehicle. Black et al. teaches the self reporting of information such as your shipping or billing address in order to make a purchase over the website. He also teaches the merchant comparing the shipping and billing address for the purposes of security in the transaction the rating being a confirmation or hold on the purchase for the purpose of security. It would have been obvious to one of ordinary skill in the art, at the time of invention, to have modified the combination of Goeller et al. and Hampton to further comprises the ability to provide the user to self report their shipping or billing address that is indicative of their geographic location, and to provide a system of billing and shipping address comparison by a merchant for the well known purpose of confirming the billing information and/or shipping information and the security or integrity of the purchaser

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in a transaction. Regardless, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to combine geographic location technology with a retail website or sales website or otherwise in order to confirm and/or provide internet security through logging of IP addresses. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable. (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.")

21. Claims 15, 24, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Goeller et al. and Hampton in view of Black et al. (US 2003/0023541) and further in view of Klingman (US 5,950,172).

22. With respect to claims 15, 24 and 35, Goeller et al., Hampton and Black et al. teach all the limitations of claims 1, 12-14; 17, 22-23 and 25-27 respectively, except for explicitly reciting that the website provides a service whereby users of said website transact business with other users of said website and further wherein users of said website provide feedback information to said website about other users of the website with whom they have transacted business indicative of the integrity of the other users and wherein the integrity data comprises said feedback information. Klingman teaches the use of a feedback system for providing feedback information on the integrity of its users. It would have been obvious to one of ordinary skill in the art,

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at the time of invention to have modified the combination of Goeller et al., Hampton, and Black et al. with a feature to provide feedback on other users as taught by Klingman for the well known purpose of providing feedback on the services provided from retailers or from sales of other users to better serve the public and provide information on the potential reliability of service rendered. Regardless, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to combine geographic location technology such as IP logging with website feedback systems or otherwise in order to confirm and/or provide internet security through logging of IP addresses to trace and or mediate offensive or abusive comments or posts online. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable. (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.")

Response to Arguments

23. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection. In particular, Applicant's response points primarily to the claim reciting "obtaining via a communications network and the communications interface, *user-reported* data purportedly disclosing respective geographic locations of a plurality of users of the

communications network.” It is the Examiner’s position that the user-reported data, in the least, may include the users request data packets which purports the location of the user through internet hops. The fact that the data is cross-checked by the ICANN database for accuracy is additionally helpful. Further, with respect to claims 2 and 18, as shown in the rejection of the claims, the system explicitly if no inherently employs a system of rating to determine whether the results are accurate or not.

Conclusion

24. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/
Examiner, Art Unit 3629

/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3629